Remarks and Arguments

Claims 1-2, 9-10,12, and 19-21 are pending in this application. Claims 1, 10, and 19 are amended to more particularly point out the invention. Support for the amendments in claim 1 can be found in Figures 1-8. Support for the amendment in claim 19 can be found on page 6, lines 8-29. Support for new claim 21 is found on page 4, lines 16-27 of the specification. Claims 1-2. 9-10, 12 and 19 stand rejected. Each of the rejections is addressed below.

Rejection under 35 U.S.C. § 112

Claim 10 was rejected for lack of antecedent basis for the term "longitudinal overlap". This informality has been corrected.

Anticipation Under 35 U.S.C. § 102(b)

1. The Anticipation Standard

The standard required for finding anticipation under 35 U.S.C. § 102(b) is stated in MPEP § 2131. "'A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.' *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). 'The identical invention must be shown in as complete detail as is contained in the...claim'. *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989)."

A prior art reference must contain an enabling disclosure. MPEP 2121.01 states in relevant part: "[i]n determining that quantum of prior art disclosure which is necessary to declare an applicant's invention 'not novel' or 'anticipated' within section 102, the stated test is whether a reference contains an 'enabling disclosure'... ." *In re Hoeksema,* 399 F.2d 269, 158 USPQ 596 (CCPA 1968). The disclosure in an assertedly anticipating reference must provide an enabling disclosure of the desired subject matter; mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation. *Elan Pharm., Inc. v. **>Mayo Found. For Med. Educ. & Research<*, 346 F.3d 1051, 1054, 68 USPQ2d 1373, 1376 (Fed. Cir. 2003)."

2. Claims 1 and 12

Claims 1 and 12 stand rejected under 35 U.S.C. 102(b) under Pinchasik et al. (U.S. Patent No. 5,449,373). Modified claim 1 requires that a plurality but not all apex portions are connected to more than one circumferential support structure. In particular, it requires that a plurality but not all of the *adjacent* circumferentially disposed structures be thus interconnected at apex portions. All apex portions of Pinchasik are interconnected by flexible connectors with adjacent apex portions, and hence Pinchasik does not anticipate.

For at least this reason, claim 1, and all claims that depend from it, are not anticipated by Pinchasik et al.

3. Claims 1, 2, 10, 12, and 19

Claims 1, 2, 10, 12, and 19 are rejected under 35 U.S.C.102(b) as being anticipated by Wijay (U.S. Patent Number 5,824,059).

Applicants respectfully submit that Wijay does not anticipate amended claim 1. Referring to Figures 3 and 4, Wijay teaches that each circumferential support structure is interconnected to an adjacent circumferential support structure at only one apex portion (i.e., "apex portion" is defined in the instant specification, page 3, line 30, through page 4 line 1, as the region where two longitudinal struts are joined). It does not teach apex to apex connection. Wijay explains why this alternating pattern of apex to non-apex connections is used: "As a result, crosstie 90, when the stent 58 is expanded, puts a clockwise force on segment 88, while crosstie 94, when the stent 85 is radially expanded, puts a counterclockwise force on segment 86. The net result of the crossties 90 and 94 is to apply a closing force to segments 86 and 88, which make up the longitudinal opening 80, so that there is a greater resistance to growth of the opening 80 than there is to the widening of an individual set of return bends, such as 100. In a similar manner, the longitudinal openings 82 and 84 are impacted by their crossties from above and below" (col. 7 line 2-12). Wijay goes on to state that more than one adjacent ring can be next to another adjacent ring (col. 7, lines 30-35), but does not explain how such a design could achieve the stated goal of applying a closing force to segments. Wijay crossties are critically interconnecting the end struts which

form the border of each longitudinal gap, and consequently cannot be relocated to adjacent apex portions without compromising the "counteracting" force needed to prevent the gaps from opening during stent expansion. Such a design would fail to achieve Wijay's stated goal since all such crossties would attach to apex portions at both ends, and hence would not exert a clockwise or counterclockwise force on segments. Hence, this embodiment is not enabled and does not anticipate the claimed invention.

Applicants note that the Patent Office has failed to state why it thinks that claim 19 is anticipated by Wijay, and Applicants respectfully request such clarification. Applicants note that claim 19 includes the following limitation "the circumferential connecting struts extending between the apex portions of adjacent circumferential support structures", and respectfully submit that claim 19 is novel for the same reasons as claim 1.

In addition, claim 19 includes the following limitation "wherein when the stent body is generally straight, some pairs of adjacent circumferential support structures have adjacent apex portions that oppose one another, and other pairs of adjacent support structures have adjacent apex portions that are circumferentially staggered so as to not oppose one another, the circumferential staggering being provided by the circumferential connecting struts.". Applicants respectfully submit that this is not taught or suggest by Wijay either alone or in combination with other limitations of claim 19. Indeed, none of the apex portions illustrated in Wijay (e.g., Figs. 1-5) are directly opposed.

Applicants respectfully submit that Wijay does not teach this limitation, nor all limitations in claim 1 from which claim 19 depends.

Obviousness Under 35 U.S.C. § 103

1. The Obviousness Standard

MPEP §2143 provides the standard required to establish a prima facie case of obviousness. "First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there

must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim limitations."

The motivation to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not the applicant's disclosure. *In re Vaeck,* 947, F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). The references must be considered as a whole and must suggest the desirability, and thus the obviousness of making the combination. *Hodosh v. Block Drug Col, Inc.,* 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986); MPEP § 2141. The Patent and Trademark Office (PTO) bears the burden of initially establishing a prima facie case of obviousness. MPEP §2142. The PTO has not met its burden in the instant case.

2. Claims 2, 9, 19, and 20

Claims 2, 19, and 20 stand rejected as allegedly obvious under 35 U.S.C. § 103 pursuant to Pinchasik in view of Wijay. Claim 9 is rejected as allegedly obvious over Wijay in view of Pinchasik. For at least the reasons described above, the Patent Office has not cited references that teach all the claim limitations of claims 1 and 19, and thus of dependent claims 2 and 20.

The inventive stent provides a number of benefits over the prior art, including improved wall coverage, improved flexibility through out the stent, and improved radial strength through out the stent. Neither Wijay nor Pinchasik suggest the modifications necessary to attain these benefits nor do they teach that each of these benefits can be accomplished by the inventive features of claimed invention.

RECONSIDERATION

It is believed that all claims of the present application are now in condition for allowance.

Reconsideration of this application is respectfully requested. If the Examiner believes that a teleconference would expedite prosecution of the present application the Examiner is invited to call the Applicant's undersigned attorney at the Examiner's earliest convenience.

Any amendments or cancellation or submissions with respect to the claims herein is made without prejudice and is not an admission that said canceled or amended or otherwise affected subject matter is not patentable. Applicant reserves the right to pursue canceled or amended subject matter in one or more continuation, divisional or continuation-in-part applications.

To the extent that Applicant has not addressed one or more assertions of the Examiner because the foregoing response is sufficient, this is not an admission by Applicant as to the accuracy of such assertions.

Please grant any extensions of time required to enter this response and charge any fees in addition to fees submitted herewith that may be required to enter/allow this response and any accompanying papers to our deposit account 02-3038 and credit any overpayments thereto.

Respectfully submitted,

Date: 4/25/06

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